REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed January 4, 2006. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

Claims 1-25 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Applicants acknowledge this provisional rejection but deem that a response is premature in that none of the rejected claims has been found patentable over the prior art of record. At such time as claims 1-25 have been otherwise found allowable, Applicants will make an appropriate response to this provisional rejection if still pending.

The Examiner has rejected claims 1, 6, 7, 11, 16, 17, 18, and 21 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2003/0041053 A1, issued in the name of Roth (hereinafter referred to as "Roth"). This ground of rejection is respectfully traversed as to amended claims 1, 6, 7, 11, 16, 17, 18, and 21 for the reasons provided below.

The standard for the finding of anticipation during the examination process may be found in MPEP 2131, which states in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element
as set forth in the claim is found, either expressly or
inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814
F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
**"The identical invention must be shown in as complete
detail as is contained in the ... claim."** *Richardson v.
Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913,
1920 (Fed. Cir. 1989). (emphasis added)

The rejection of amended claims 1-25 as anticipated by Chau is

respectfully traversed because "each and every element as set

forth in the claim[s] is" **not** "found, either expressly or

inherently described" in Chau and to the extent found in Chau,

"**the identical invention**" is not "**shown in as complete detail as**

is contained in the ......claim"..

In accordance with a major aspect of Applicants' invention,

a user terminal generates a service request in a first format

which is transferred via a publically accessible digital data

communication network to a legacy data base management system

which must convert the service request into a different format to

permit the service request to be honored through the execution of

an ordered sequence of command language script. In each claim,

the user terminal generates the service request as an XML

document in accordance with information provided by the legacy

data base management system and yet the legacy data base

management system is unable to directly honor an XML service

request until converted into a second format.

Roth shows four primary embodiments (i.e., the embodiments of Figs. 1, 4, 5, and 6). The embodiments of Figs. 1, 4, and 5 all show the transfer of queries from client computer 102 to the search engine as an XML message. The embodiment of Fig. 6 shows that the search tools and conversion modules are all located within client computer 102, such that there is no transfer of an incompatible query from client computer 102. Thus, none of the embodiments of Roth can meet the requirements of MPEP 2131, because in none of the embodiments of Roth is there an XML query created in accordance with information supplied by the data base management system. Furthermore, as explained below, it is improper for the Examiner to attempt to combine these mutually exclusive embodiments in a manner to find all of the "pieces" of Applicants' claimed invention without showing the claimed invention in total.

With regard to the rejection of claim 1, the first limitation is a "legacy data base management system". In making his rejection, the Examiner apparently finds no particular element or teaching of Roth which corresponds to this claimed element, because he does not cite any portion of the reference.

The second element of claim 1 is a "a user terminal coupled to said legacy data base management system via said publicly accessible digital data communication network which **generates an XML service for requesting said legacy data base management**

system to process said XML document in a specified manner". In
making his rejection, the Examiner finds that "terminal" of page
7, paragraph 0087, reads on "client computer" 102. This finding
does not address Applicants' claimed invention, because "client
computer" 102 of paragraph 0087 does not "request said legacy
data base management system to process said XML document" as
claimed. In fact, "client computer" 102 only transfers SQL
queries to "server computer" 150 (see Fig. 6).

The third claimed element, as amended[1], is the "input
definition facility" located within the claimed legacy data base
management system which defines and loads the input. To find
this element, the Examiner returns to the embodiment of Fig. 6
citing element 508, which the Examiner admits being located
within "client computer" 102. Thus this element is not found in
Roth.

The rejection of amended claim 1, and all claims depending
therefrom, is respectfully traversed for failure of Roth to meet
the requirements of MPEP 2131.

Claim 6 is an independent apparatus claim having four
separate element coupled together in a specific manner. In
making his rejection, the Examiner cites relational data base 160
to correspond to the second claimed element, "legacy data base

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[1]Support for this amendment is found throughout Applicants'
disclosure and is summarized at page 11, lines 15-22.

management system". Because there is no XML message transferred to Fig. 6, element 160, the Examiner admits that the query is transferred to server computer 150 as an SQL query. Thus, the third claimed element, "a facility which generates an input service requesting that said data base management system process an XML document" cannot be found in Roth, because server computer 150 never receives an XML document so it can never "process an XML document" as claimed.

The fourth claimed element is a "converter". In making his rejection, the Examiner cites client computer 102 as containing this element. To assist the Examiner in understanding Applicants' invention, claim 6 has been amended to explicitly require that the "converter" be located within the claimed "legacy data base management system". As explained above, support for this limitation is found in the specification. This is readily distinguishable from the Examiner's current rejection wherein client computer 102 of Roth is alleged to contain the fourth claimed element. Therefore, the rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claims 7 and 18 depend from claims 6 and 17, respectively, and further limits the claimed "input service" to an "XML service". As explained above, the embodiment of Fig. 6 of Roth transfers only SQL and never transfers an XML service request.

Therefore, Roth cannot have the further limitations of claims 7 and 18. The rejection of claims 7 and 18 is respectfully traversed.

Claim 11 is an independent method claim having four basic steps. The first step requires: "retrieving a sample document from a repository of said legacy data base management system". In making his rejection, the Examiner cites page 4, paragraph 0057, which refers to the embodiment of Fig. 1 of Roth which has nothing to do with the claimed element. There is no showing of a "sample document" within any of the embodiments of Roth.

The second step requires "editing said document into said XML input service by said user terminal". Having no such sample document, certainly Roth cannot edit it. Therefore, the Examiner cites page 5, paragraph 0060, stating:

> ...."editing" reads on "translates", and wherein "input service" reads on "XML results".

This statement is both clearly erroneous and legally irrelevant. It is clearly erroneous because "input service" (i.e., service request) cannot possibly be "XML results" (i.e., the response to honoring of a service request). Furthermore, it is disingenuous for the Examiner to even suggest that "Search Engin Module 152, which translates[2]" which occurs in server computer 150 (see Fig. 1) is the same as the claimed "editing" by the claimed "user terminal". In addition, the Examiner's finding is legally

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[2]See Roth page 5, paragraph 0060, lines 12-13.

irrelevant, because it does not address Applicants' claimed invention.

As originally presented, it is implied that the "converting" step (i.e., third step) occurs within the data base management system. Therefore, the Examiner jumps from the embodiment of Roth Fig. 1 to the mutually exclusive embodiment of Roth Fig. 6. This is impermissible as a matter of law.

The fourth step is limited by "presenting" the converted request. This requires presentation of the converted XML document to the claimed "legacy database management system" which is not found in Roth. The rejection of claim 11, and all claims depending therefrom, is respectfully traversed for failure of Roth to meet the requirements of MPEP 2131 and for failure of the Examiner to address Applicants' claimed invention.

Claim 12 depends from claim 11 and further limits the claimed "sample document" to an "XML document". In making his rejection, the Examiner again cites page 4, paragraph 0056, which has nothing to do with the claimed "sample document". Furthermore, as if to confuse the matter, the Examiner states that it "shows XML send/receive". It is incongruous that the Examiner would find this pertinent to claim 12. The rejection of claim 12 is respectfully traversed.

Claim 16 is an independent apparatus claim having five "means-plus-function" limitations. As to the first three claimed

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elements which involve storage, retrieval, and editing of a "sample input service, the Examiner cites paragraphs 0057, 0054, and 0060 of Roth which say nothing of the claimed "sample input service". This occurs because Roth has no "sample input service". Therefore, the Examiner cites material having no relation to the claimed invention.

To further highlight Applicants' invention, the fourth element has been amended to make it more explicit that the "storing means" is located within the "providing means". For a host of reasons, this limitation cannot be found in Roth.

The final element of claim 16 is a "transferring means" which transfers the edited sample input service to the providing means for honoring. This is not found in Roth so the Examiner again jumps to the embodiment of Fig. 6. As explained above, Roth does not have a "sample input service". Therefore, Roth cannot have these further elements. The rejection of amended claim 16, and all claims depending therefrom, is respectfully traversed for failure of Roth to meet the requirements of MPEP 2131.

Claim 17 depends from claim 16 and further limits the "providing means" to include a "repository means". This element is not found in Roth. The rejection of claim 17 is respectfully traversed.

Claim 21 is an independent apparatus claim having three basic elements. Roth has none of these elements. The first element is a "user terminal" which makes an XML data processing service request and receives a corresponding response. There is no showing that Roth has any user terminal that receives the claimed "response".

The second element is a "converter". As explained above, the "converter" cannot be located within the user terminal as suggested by the Examiner by citing the embodiment of Fig. 6 of Roth (i.e., citing page 7, paragraph 0089). The rejection of claim 21, and all claims depending therefrom, is respectfully traversed.

Claims 2-5, 8-10, 13-15, and 19-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of U.S. Patent No. 6,934,712, issued to Kieran et al (hereinafter referred to as "Kiernan"). This ground of rejection is respectfully traversed for failure of the Examiner to make a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1)motivation to make the alleged combination; 2)reasonable likelihood of success of the alleged combination; and 3)all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings.

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Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

The Examiner makes no legally cognizable showing of motivation to make the alleged combination as required by MPEP 2143. He simply concludes that it is "obvious" to make the alleged combination without providing evidence and/or argument showing "why" as required by law. The Examiner further completely ignores his requirement to show reasonable likelihood of success.

With regard to claims 2, 8, 13, and 19 which require a "plurality of variables" be included in the claimed XML service, the Examiner simply cites Kiernan as showing a "plurality of variables" without explaining how Roth could possibly utilize such "plurality of variables" in its conversion to an SQL query. The rejection of claims 2, 8, 13, and 19 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as required by MPEP 2143.

With regard to claims 3, 14, and 20 which require a "plurality of tables" be included in the claimed XML service, the Examiner simply cites Kiernan as showing a "plurality of tables" without explaining how Roth could possibly utilize such "plurality of tables" in its conversion to an SQL query. The rejection of claims 3, 14, and 20 is respectfully traversed for

failure of the Examiner to present a *prima facie* case of obviousness as required by MPEP 2143.

Claims 4 and 15 depend from claims 3 and 14, respectively, and are further limiting of the XML service request to include "executable script". Though the alleged combination may mention "executable script", the claim requires that the claimed "executable script" be a portion of the XML service request which is not found in the alleged combination. The rejection of claims 4 and 15 is respectfully traversed for failure of the Examiner to address the claimed invention.

Claims 5 and 10 depend from claims 4 and 9, respectively, and are further limiting of the coupling network. As explained above, the alleged combination does not meet the limitations of claim 4 and 9 from which claims 5 and 10 depend. Therefore, the alleged combination cannot have the further limitations of claims 5 and 10. The rejection of claims 5 and 10 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by "said facility further comprises a plurality of sample XML messages". The Examiner has previously found that the claimed "facility" is disclosed by Roth at page 7, paragraphs 0085-0086 (see page 5, lines 1-2 of the pending office action), which is the embodiment of Fig. 5. Yet, in his rejection of claim 9, the Examiner somehow finds that the further limitations which claim 9 require

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of the claimed "facility" are found in paragraph 0056 (i.e., the embodiment of Fig. 1). The rejection of claim 9 is respectfully traversed as logically and legally inconsistent.

Claims 22-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of U.S. Patent Publication No. 2003/0023463A1, issued in the name of Dombroski et al (hereinafter referred to as "Dombroski"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

The Examiner again fails to show motivation and again completely ignores his obligation to show reasonable likelihood of success. Furthermore, claims 22-25 depend from claim 21 and present further limitations not found in the alleged combination. For example, Dombroski parenthetically mentions a "mainframe computer" but says nothing of the claimed "legacy data base management system".

Claims 23 further limits the software architecture of the claimed "user terminal". Contrary to the assertion of the Examiner, paragraph 0044 of Roth says nothing of software architecture of any computer.

Claim 24 is further limited by a "repository" which stores "native command language". The alleged combination does not have these limitations. Therefore, the Examiner cites Roth paragraphs 0066-0068 alleging that "native command language" reads on "the

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Operator box". This statement is so clearly erroneous, it makes no sense.

Claim 25 is further limited by sample XML messages. The prior art of record contains no such elements as explained in detail above. The rejection of claims 22-25 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.
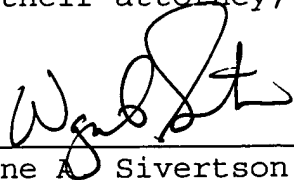
Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

Thomas N. Turba et al.

By their attorney,

Date___April 4___, 2005___

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Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, Minnesota
55413
(612) 331-1464